

REMARKS

The Applicant hereby traverses the restriction requirement and asks for its reconsideration and withdrawal. The Examiner is requested to withdraw the restriction requirement and concurrently examine all of the claims now in the application. The avowed purpose of the Patent & Trademark Office in requiring an election, whether part of a species or invention restriction, is the avoidance of a burdensome examination, i.e., to avoid multiple searches, etc. However, MPEP §803 provides that, if the search and examination of an entire application can be made without serious burden, the examiner is encouraged to examine it on the merits even if it is considered to include claims to two different or independent inventions.

It is respectfully submitted that the examination of all the claims in this application will not place an undue burden on the Patent Office.

The Examiner has divided the claims into five groups, namely, Group I, containing claims 1-5; Group II containing claims 6, 9, 10, 15 and 16; Group III containing claims 7, 8 and 11-14; Group IV, containing claims 18-25; and Group V claims containing claims 26-28. As indicated above, the Applicant provisionally elects the Group II claims. However, the Group III claims are all dependent claims, which depend directly or indirectly from independent claim 6, which is part of the Group II claims. If claim 6 is allowed, then the Group III claims that depend directly or indirectly from claim 6 are also allowable. Accordingly, the Group II and Group III

claims should be concurrently examined. Why should the Applicant be forced to incur the expense of a separate divisional application for dependent claims?

How is the Patent Office burden reduced by separating these four dependent claims? These four dependent claims feature details of a movement control member and should be examined concurrently with their parent claims. Moreover, claim 1 (which is part of the Group I claims), recites a diverter and bypass function and also calls for a "changeable stop member for limiting movement in the valve member". In examining the Group II and Group III claims, the Examiner will have to search the art for a "changeable stop member". Certainly, that same art will have to be searched for a "movement control member" when the Group I claims are examined. In other words the Examiner's search burden is not reduced by excluding claims 6, 9, 10, 15 and 16 from the Group I claims and excluding claims 7, 8 and 11-14 from the Group II claims. In conclusion, the Group II and Group III claims should be examined together with the Group I claims.

The Examiner asserts that the Group IV claims, namely 18-25, are drawn to a valve with another particular spool structure (emphasis added). What other particular spool structure is the Examiner referring to? Referring to the Group I claims, claim 3, which depends from claim 1, calls for a valving member that includes a pair of spaced apart disk-like members. Independent claim 6 calls for a valve spool that includes a disk-like member.

Claim 18, which forms part of the Group IV claims, calls for a disk member. Claims 19-25 depend directly or indirectly from claim 18. It should be apparent, that the Group I claims and the Group IV claims all call for either a disk-like member or a "disk member". In performing the prior art search for the Group I claims and/or the Group III claims, the Examiner will have to search for "disk-like members forming part of a valving member or a valve spool". This same art will have to be searched for a "disk member" when the Group IV claims are examined. How, then, is the search burden reduced by creating a separate group for claims 18-25? Increasing the expense of prosecuting all of the claims in the subject application by requiring divisional applications is unjustified in view of the above.

The Group V claims are dependent claims that depend directly or indirectly from claim 18. If claim 18 is allowed, then the Group V claims are also allowable. How can they be arbitrarily excluded from the Group IV claims?

The search burden on the Examiner is not reduced by this restriction requirement. The search and examination of the entire application can be made without serious burden and, accordingly, the Examiner should examine all of the claims in this application as suggested by MPEP §803.

Please charge any deficiency or credit any overpayment in the fees for this response to our Deposit Account No. 20-0090.

Respectfully submitted,

/John R. Hlavka/

John R. Hlavka

Reg. No. 29,076

TAROLLI, SUNDHEIM, COVELL,
& TUMMINO LLP

CUSTOMER NO.:26294

Phone:(216) 621-2234

Fax: (216) 621-4072